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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Eiji Takahashi

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EXAMINER

NIGH, JAMES D

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/576,626	<b>Applicant(s)</b> TAKAHASHI, EIJI	
	<b>Examiner</b> JAMES D. NIGH	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>21 April 2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to application filed on 21 April 2006. Claims 1-15 are presented for examination on the merits.

#### ***Priority***

2. Receipt is acknowledged of papers submitted 21 April 2006 under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) was submitted on 21 April 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Examiner's Comment***

4. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See MPEP § 2106 II C.

See also MPEP § 2111.04.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. **Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

7. Claims 1, 5, 6, 7, 13 and 14 each recite “are exist”. The scope of the claim cannot be ascertained as the expression “are exist” is unclear and is therefore indefinite “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...”, *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)

8. Claims 2-4 are also rejected as being dependent upon claim 1.

9. Claim 6 is also rejected as being dependent upon claim 5

10. Claims 8-12 are also rejected as being dependent upon claim 7.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan (U.S. Patent PG Publication 2002/0019814, hereinafter referred to as Ganesan).**

13. As per claims 1 and 13

Ganesan discloses a terminal apparatus that obtains the contents (Figure 4, 0036, 0044, 0047, 0057)

Ganesan discloses a server connected to the terminal apparatus through a communication line to provide, for the terminal apparatus, a license that permits the use of the contents (Figure 7, Figure 9, 0009)

Ganesan discloses a terminal apparatus containing a storage unit (0039-0040)  
“that stores...” is intended use

Ganesan discloses storing content and licenses (Abstract, 0009-0017) and event information (0018-0019) which in the broadest reasonable interpretation can be deemed a terminal state; however the expression “terminal apparatus information indicating a terminal state related to the contents and the license” is simply descriptive material and as the claimed data has no manipulative effect on any of the structure it is nonfunctional in nature and therefore is not entitled to any patentable weight “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, “We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability”, *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

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Ganesan discloses a communication unit that transmits an acquisition request to obtain a license that corresponds to the contents (0010); however “that transmits...” is a statement of intended use

Ganesan discloses a server receiving unit that receives the license acquisition request (0010); however “that receives...” is a statement of intended use.

Ganesan discloses a transmission unit that transmits the license information to the terminal apparatus (0015-0016); however “that transmits...” is intended use

The expression "that designates priority levels to a plurality of licenses based on the terminal state information in a case that the plurality of licenses corresponding to the contents are exists is intended use.

The expression "indicating a correlation between the plurality of licenses and the designated priority levels" is non-functional descriptive material.

14. As per claim 2

Ganesan discloses wherein the license information preparation unit prepares a license list (0303)

Ganesan discloses “in which the designated licenses are arranged in order of high priority levels” (0303); additionally this is simply descriptive material and as the claimed data has no manipulative effect on any of the structure it is nonfunctional in nature and therefore is not entitled to any patentable weight “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter

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and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, “We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability”, *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

15. As per claim 3

Ganesan does not explicitly disclose “wherein the license information preparation unit prepares a license list in which only the licenses designated with the high priority levels are arranged”; however Ganesan teaches arranging priority levels (0303) and selection based on the priority (0303) therefore a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Ganesan would be to select and arrange only the licenses with the highest priority for the purpose of providing an enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content, where such control is flexible and definable by the content owner of such digital content. Additionally this is non-functional descriptive material.

16. As per claim 4

Ganesan discloses "wherein the license information preparation unit prepares license information that includes only the license designated with the highest priority levels" (0303); additionally this is non-functional descriptive material

17. As per claims 5 and 14

Ganesan discloses a terminal apparatus that obtains the contents (Figure 4, 0036, 0044, 0047, 0057); however "that obtains the contents" is a statement of intended use.

Ganesan discloses a server connected to the terminal apparatus through a communication line to provide, for the terminal apparatus, a license that permits the use of the contents (Figure 7, Figure 9, 0009); however "that permits the use..." is intended use.

Ganesan discloses a storage unit that stores the contents (0039-0040); however "that stores the contents" is intended use.

Ganesan discloses a transmitter that transmits a license acquisition request to the selected license acquisition request destination (0010, 0102, 0104); however "that transmits..." is intended use.

Ganesan discloses a receiver that receives the acquisition request (0010, 0102, 0104); however "that receives..." is intended use

Ganesan discloses a storage unit that stores the licenses in correlation with the acquisition request destinations (0101-0104); however "that stores..." is intended use.



Ganesan discloses a transmitter that transmits, to the terminal apparatus, the license that is correlated with the acquisition request destination designated in the license acquisition request (0101-0104); however “that transmits...” is intended use.

Ganesan does not explicitly disclose “acquisition request destination information that indicates license acquisition request destinations that correspond to a plurality of groups of the licenses in a case that the plurality of licenses corresponding to the contents are exist”; however Ganesan teaches destination information (0102, 0104) and groups of licenses (0303); therefore a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Ganesan would be to have destination information that corresponds to groups of licenses for the purpose of providing an enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content, where such control is flexible and definable by the content owner of such digital content. Additionally this is non-functional descriptive material.

Ganesan does not explicitly disclose a controller that selects at least one of the license acquisition request destinations based on the terminal state information when a license acquisition request is performed to obtain a license that corresponds to the contents. Ganesan teaches accessing destinations (0102, 0104) in order to obtain content and event information (0018-0019) which in the broadest reasonable interpretation can be deemed a terminal state. Ganesan also teaches the use of the event information in determining license storage (0237-0240), license selection (0241-0244) and license action (0249-0255). Therefore a predictable result (*KSR International*

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*Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Ganesan would be to use the event information and the license action tools in determining which destination to access for the purpose of providing an enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content, where such control is flexible and definable by the content owner of such digital content. In addition the expression “that selects...” is intended use.

18. As per claim 6

Ganesan does not explicitly disclose “wherein the server transmits a list of a plurality of licenses in a case that the plurality of licenses corresponded to the acquisition request destination are exist”; however Ganesan teaches accessing destinations (0102, 0104) and a plurality of licenses (0303); therefore a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Ganesan would be to transmit a plurality of licenses when the accessed destination provides a plurality of licenses for the purpose of providing an enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content, where such control is flexible and definable by the content owner of such digital content. Additionally this is non-functional descriptive material.

19. As per claims 7 and 15

Ganesan discloses a terminal apparatus that obtains the contents (Figure 4, 0036, 0044, 0047, 0057); however “that obtains...” is intended use.

Ganesan discloses a server connected to the terminal apparatus through a communication line to provide, for the terminal apparatus, a license that permits the use of the contents (Figure 7, Figure 9, 0009); however “that permits...” is intended use.

Ganesan discloses a receiver that receives the acquisition request (0010, 0102, 0104); however “that receives...” is intended use.

Ganesan discloses a transmitter that transmits, to the terminal apparatus, the license that is correlated with the acquisition request destination designated in the license acquisition request (0015-0016, 0101-0104); however “that transmits...” is intended use.

Ganesan discloses a receiver that receives the license information (0015-0016, 0101-0104); however “that receives...” is intended use.

Ganesan discloses a storage unit that stores the contents and terminal state information indicating a terminal state related to the contents and the licenses (0039-0040, 0103, 0116-0117); however “that stores...” is intended use.

Ganesan does not explicitly disclose a controller that edits the license list to designate priority levels to the licenses on the license list by referring to the terminal state information. Ganesan teaches client selection of multiple licenses by priority (0303), license metadata (0304) and terminal state information (0116-0117) and a dynamic authoring tool for setting up rules (0059, 0063, 0066-0067, 0069-0070); therefore a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Ganesan would to use the dynamic authoring tool to reference the terminal state information when setting the priority levels as part of the rules package for

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the purpose of providing an enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content, where such control is flexible and definable by the content owner of such digital content.

Ganesan does not explicitly disclose transmitting a license list; however Ganesan teaches accessing destinations (0102, 0104) and a plurality of licenses (0303); therefore a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Ganesan would be to transmit a plurality of licenses when the accessed destination provides a plurality of licenses for the purpose of providing an enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content, where such control is flexible and definable by the content owner of such digital content.

20. As per claim 8

Ganesan does not explicitly disclose “wherein the terminal state information indicates whether the terminal apparatus holds a license corresponding to the contents”; however Ganesan teaches a state store indicating whether the terminal holds a license (0116-0117). Additionally this is non-functional descriptive material.

21. As per claim 9

Ganesan does not explicitly disclose “wherein the terminal state information indicates the consumption state of the license”; however Ganesan teaches that the state store maintains the consumption state (0116-0117). Additionally this is non-functional descriptive material.

22. As per claim 10

Ganesan does not explicitly disclose “wherein the terminal state information indicates a period for the use of the contents”; however Ganesan teaches a period of use (0116-0117, 0154, 0205). Additionally this is non-functional descriptive material.

23. As per claim 11

Ganesan does not explicitly disclose “wherein the terminal state information indicates a method of using the contents in the terminal apparatus”; however Ganesan teaches where the state information indicates a method of using the content (0205-0206). Additionally this is non-functional descriptive material

24. As per claim 12

Ganesan discloses “wherein the terminal state information indicates a time when the terminal apparatus obtained the contents” (Figure 15, 0269-0273). Additionally this is non-functional descriptive material.

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d

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1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/  
Examiner, Art Unit 3685

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621